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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,569	08/31/2001	Bertrand Berthelot	1807.1743	9399
5514 7590 05/01/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER STEVENS, ROBERT	
			ART UNIT 2162	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/942,569

Applicant(s)

BERTHELOT ET AL.

Examiner

Robert Stevens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Office maintains/withdraws the previous rejections of the claims under 35 USC §§112-2nd paragraph and 103(a), in light of the amendment. However, the Office sets forth new rejections of the claims under 35 USC §103(a), in light of the amendment.

Response to Arguments

2. Applicant's arguments filed 2/5/2007 have been fully considered but they are not persuasive.

On page 6, Applicant's arguments concerning the previous rejections under 35 USC §112-2nd paragraph are deemed moot in light of the amendments.

Regarding the previous claim rejections under 35 USC §103(a), Applicant argues on page 8 that the Tso reference does not teach adapting "the documents in accordance with characteristics of a user terminal that are received from the user terminal, or that the documents are adapted before receiving a request for access to a document".

The Office respectfully disagrees, noting that the references as a whole teach the recited limitations. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, at least the Tso reference at col. 6 lines 55-60 and col. 7 at lines 43-55 teaches transcoding or adaptation before a request and based upon popularity (i.e., access frequency).

Regarding the previous claim rejections under 35 USC §103(a), Applicant argues on page 8 that the Mäkipää reference does not teach "that the characteristics of the user terminal are received from the user terminal". Additionally, Applicant argues that the Mäkipää reference does not teach various adaptation limitations.

The Office respectfully disagrees, noting that this is not the exact claim language recited, and that the references as a whole teach the recited limitations. At least the Mäkipää reference at col. 6 line 66 – col. 7 line 2, discusses transmission of terminal type from a user. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, the Office notes that Tso, not the Mäkipää reference, was not cited for teaching adaptation limitations.

Regarding the previous claim rejections under 35 USC §103(a), Applicant argues, on pages 8-9 that the references were improperly combined because they both do not teach transcoding (i.e., content adaptation) before a client request, and therefore they teach away from the invention.

The Office respectfully disagrees, noting that the references as a whole teach the recited limitation. At least the Tso reference at col. 6 lines 55-60 and col. 7 at lines 43-55 teaches transcoding or adaptation before a request. Additionally, in response to applicant's argument that Mäkipää and Tso teach adapting at different times and therefore are not combinable, the test for obviousness is not whether all features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Tso and Mäkipää merely teach both options (i.e., adapting before and after receipt of a request, which are noted as being obvious variants in light of each other.

For at least these reasons, the Office asserts the rejections of the claims as set forth below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 19-24 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Tso (US Patent No. 6,959,318 filed Mar. 6, 1998 and issued Oct. 25, 2005, hereafter referred to as "Tso") view of Mäkipää et al. (US Patent No. 6,556,217 filed Jun. 1, 2000 and issued Apr. 29, 2003, hereafter referred to as "Mäkipää") and further in view of "Spyglass Prism: Concepts and Applications", Spyglass, Inc., © 1997, pp. i-ii and 1-8, hereafter referred to "Spyglass".

Regarding independent claim 19, Tso discloses: ***A server for providing a document via a network***, (See Tso Abstract and Figure 1.) ***comprising: determining means for determining an order for adapting documents for outputting the documents according to a frequency of access to the documents***; (See Tso col. 7 lines 50-51, teaching the probability that a page will be accessed, and col. 7 line 65 – col. 8 line 7, discussing the use of "access frequency information" to determine how popular a link is.) ***the selected documents in said determined order before receiving a request for access to a document***; (See Tso col. 6 lines 55-60 and col. 7

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lines 43-55, discussing transcoding prior to a request based upon link popularity.)

reading means for reading out an adapted document upon reception of the request for access to said document; (See Tso col. 6 lines 49-67, discussing storing and reading out of an adapted document.) ***and sending means for sending the document read out by the reading means to the user terminal.*** (See Tso Figure 1, shows a full duplex communication path between client 20 and server 35 via the Internet.)

However, Tso does not explicitly disclose the remaining limitations as claimed. Mäkipää, though, discloses ***receiving means for receiving, from a user terminal, characteristics related to the user terminal*** (See Mäkipää Figure 3 #160 and col. 3 lines 14-20 and col. 6 lines 28-40, teaching the reception of terminal characteristics. Also see col. 6 line 66 – col. 7 line 2, discussing transmission of terminal type from a user.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Mäkipää for the benefit of Tso, because to do so would have allowed a user to view content regardless of the user's terminal screen size, as taught by Mäkipää in the Abstract. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

Additionally, Tso does not explicitly disclose the remaining limitations as claimed. Spyglass, though, discloses ***selecting means for selecting documents according to***

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the determined order; (See Spyglass page 3 section entitled "Caches content", discussing faster response time for popular documents.) ***adapting means for adapting for output, in accordance with the received characteristics related to the user terminal,*** (See Spyglass page 5 in the first two paragraphs under "Content Converter and Cache", discussing content conversion and checking the cache for previously requested converted documents.) ***receiving means for receiving a request for access to a document;*** (See Spyglass page 4 "HTTP Server Core" section, discussing support for many Web clients.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the teachings of Spyglass for the benefit of Tso in view of Mäkipää, because to do so would have allowed a system designer to adapt PC-formatted content for display on PDAs and other devices, as taught by Spyglass in the first paragraph under "Introducing Spyglass® Prism" on page 2. These references were all applicable to the same field of endeavor, i.e., transcoding of networked-served documents.

Regarding claim 20, Tso discloses use of a threshold based upon document access. (See Tso col. 7 lines 55-60, discussing a "cut off probability" [i.e., a threshold]. Tso further discloses the use of "access frequency information" to determine how popular a link is in col. 7 line 65 – col. 8 line 7.)

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Regarding claim 21, Tso discloses adapting all server documents. (See Tso col. 6 lines 49-60, discussing transcoding all documents by a proxy server.)

Regarding claim 22, Tso does not explicitly disclose these limitations. Mäkipää, though, discloses the use of screen size user terminal characteristics. (See Mäkipää Abstract, teaching the use of terminal screen size, and col. 3 lines 14-19, discussing calculation of display space based upon user terminal screen size.)

Independent claim 23 is directed to a method implemented by the means of the server of independent claim 19. As such, this claim is substantially similar to claim 19 and likewise rejected.

Claim 24 is directed to a computer readable storage medium storing a program to implement the method of claim 23. As such, this claim is substantially similar to claim 23 and likewise rejected.

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Non-Patent Literature

Bharadvaj, Harini, et al., "An Active Transcoding Proxy to Support Mobile Web Access", Proceedings of the 17th IEEE Symposium on Reliable Distributed Systems, West Lafayette, IN, Oct. 20-23, 1998, pp. 118-123.

"Spyglass Prism 1.0", Spyglass, Inc., © 1997, pp. 1-2.

US Patents

Camut et al	6,684,257
Li et al	6,345,279
Himmel	6,167,441
Yamaguchi	6,098,069
Kawakura	5,903,901
Yoda	5,890,173

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Stevens whose telephone number is (571) 272-4102. The examiner can normally be reached on M-F 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Robert Stevens
Examiner
Art Unit 2162

April 26, 2007


MOHAMMAD ALI
PRIMARY EXAMINER